

Notice of Allowability

Application No.

09/855,916

Examiner

Marc S. Zimmer

Applicant(s)

LARSON ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/01/04.
2. ☒ The allowed claim(s) is/are 11, 12, 15, 16, 18, 19, 23-26, 45, 46, 49, 52-57, 59-66, 68-77, 79, 80 and 87-94.
3. ☒ The drawings filed on 15 May 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Allowable Subject Matter

Applicant has simply canceled all of the claimed subject matter that had been rejected either under 35 U.S.C. § 112 or 35 U.S.C. § 102 leaving only the claims that had been indicated by the Examiner as being allowable in the correspondence dated November 21, 2003.

Presently, claims 11, 15, 16, 45, and 49 are independent. Claims 11, 15, and 16 recite a marking composition and claims 45 and 49 contemplate an substrate having the markable compositions of claims 14 and 15 respectively disposed thereon.

During the course of this prosecution, Ternoir et al., U.S. patent # 5,275,645, Lutz et al., U.S. patent # 5,973,044, Koerner et al., U.S. patent # 4,749,764, Decker et al., U.S. patent # 5,998,560, Wilt, U.S. patent # 5,939,491, Elias, U.S. patent # 4,565,045, and Schonofelder et al., U.S. patent # 4,444,973.

Lutz discloses an organopolysiloxane composition that teaches essentially all aspects of the claimed invention including a polysiloxane having a substitution pattern (phenyl groups) that would yield an optically discernable mark were a high energy source to be applied and, in one embodiment, an amide-functionalized silane that corresponds to the blocked catalytic crosslinker. However, there is no suggestion that the amide-functionalized silane should be employed in concert with a phenyl group-substituted polysiloxane nor does the prior art encourage this combination.

The polymer system disclosed by *Wilt* omits mention of a component that corresponds to the blocked catalytic crosslinking agent or the optical tag

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disclosed in claims 15 and 49. The same is true of *Koerner*, *Schonfelder* and *Decker*. *Ternoir* discloses a similar composition to that delineated in claims 11 and 16 but the catalytic crosslinking agent (amino-functional silane) is not blocked.

The references cited herein represent, in the Examiner's estimation the closest prior art. Insofar as they fail to even render obvious the instantly claimed invention, claims 11-12, 15-16, 18-19, 23-26, 45-46, 49, 52-57, 59-66, 68-77, 79-80, and 87-94 are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 27, 2004

A handwritten signature in black ink, reading "Margaret G. Moore". The signature is fluid and cursive, with the first name "Margaret" and last name "Moore" clearly distinguishable.

MARGARET G. MOORE
PRIMARY PATENT EXAMINER
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